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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,150	09/04/2001	Kenichiro Kami,	12-006	9102

23400 7590 11/06/2006

POSZ LAW GROUP, PLC  
12040 SOUTH LAKES DRIVE  
SUITE 101  
RESTON, VA 20191

EXAMINER

DOVE, TRACY MAE

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 11/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/944,150

Applicant(s)

KAMI ET AL.

Examiner

Tracy Dove

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1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20,23,24,26-28 and 32 is/are pending in the application.
- 4a) Of the above claim(s) 24,26 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20,23 and 27 is/are rejected.
- 7) ☒ Claim(s) 32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

This Office Action is in response to the communication filed on 8/30/06. Applicant's arguments have been considered, but are not persuasive. Claims 20, 23, 24, 26-28 and 32 are pending. Claims 24, 26 and 28 are withdrawn from consideration. This Action is FINAL.

#### ***Election/Restrictions***

Applicant's election without traverse of Group III in Paper No. 10 is acknowledged. Election without traverse of polymer material species "polybutylene terephthalate" and modifier material species " $\gamma$ -(methacryloxypropyl) triethoxy silane" in the response filed on 11/23/04 is acknowledged. Applicant states claims 20, 23, 27 and 32 read on the elected species. Claims 24, 26 and 28 are withdrawn because they are directed toward a nonelected species.

#### ***Claim Analysis***

The claims recite the transitional phrase "composed of", which has been interpreted in the same manner as either "consisting of" or "consisting essentially of," depending on the facts of the particular case. See MPEP 2111.03. See claims 23 and 27.

The claims recite "for a non-aqueous electrolyte secondary battery", which is not given patentable weight because it is an intended use limitation.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 27 recites the limitation "said predetermined substituent". This limitation lacks antecedent basis.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 20, 23 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamanaka et al., US 5,852,108.

Yamanaka teaches a reinforced resin composition comprising a composite particulate material and a thermoplastic resin material (D). The composite material contains an inorganic material (A) and an elastic polymer material (B). The inorganic material (A) may be surface treated with a silane compound such as  $\gamma$ -methacryloxypropyltrimethoxysilane (2:57-3:3). The elastic polymer (B) has functional groups capable of forming chemical bonds with the resin to be reinforced. The term "functional groups" is meant to include functional groups capable of forming covalent bonds through chemical reactions with the thermoplastic resin (D) (3:4-31). The elastic polymer (B) may contain a  $\gamma$ -methacryloxypropyltrimethoxysilane unit (5:52-54). Typical examples of thermoplastic resin (D) include polyester resin such as polybutyleneterephthalate. Yamanaka teaches polybutyleneterephthalate is a preferred thermoplastic resin due the balanced mechanical properties and moldability (8:10-9:19).

Note canceled claim 21 has been incorporated into claim 20. Applicant stated claim 21 reads on the elected species. Since Yamanaka teaches the elected species, the claims are anticipated.

***Response to Arguments***

Applicant's arguments filed 8/30/06 have been fully considered but they are not persuasive.

The objection to the specification is withdrawn. The 35 U.S.C. 112, 1<sup>st</sup>, rejections are withdrawn.

Applicant argues Yamanaka fails to teach or suggest a porous film consisting of the modified polymer material that has been modified by the first modifier. Examiner disagrees. Yamanaka teaches the inorganic material (A) may be surface treated with a silane compound such as  $\gamma$ -methacryloxypropyltrimethoxysilane (2:57-3:3). The elastic polymer (B) has functional groups capable of forming chemical bonds with the resin to be reinforced. The term "functional groups" is meant to include functional groups capable of forming covalent bonds through chemical reactions with the thermoplastic resin (D) (3:4-31). The elastic polymer (B) may contain a  $\gamma$ -methacryloxypropyltrimethoxysilane unit (5:52-54). Typical examples of thermoplastic resin (D) include polyester resin such as polybutyleneterephthalate. Yamanaka teaches polybutyleneterephthalate is a preferred thermoplastic resin due the balanced mechanical properties and moldability (8:10-9:19). The inorganic particulate material is coated with the polybutyleneterephthalate/ $\gamma$ -methacryloxypropyltrimethoxysilane, thus, a porous film of polybutyleneterephthalate/ $\gamma$ -methacryloxypropyltrimethoxysilane covers the inorganic particulate material (A).

***Allowable Subject Matter***

Claim 32 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Yamanaka does not teach or suggest the resin material as part of the electrodes of a non-aqueous secondary battery.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tracy Dove whose telephone number is 571-272-1285. The examiner can normally be reached on Monday-Thursday (9:00-7:30).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 1, 2006



TRACY DOVE  
PRIMARY EXAMINER